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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,480	05/31/2001	Alfred Steini	3986-4	1532

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/05/2003

28

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,480

Applicant(s)

STEINL, ALFRED

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 21, 2003 has been entered.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Paper #7 on April 5, 2002. It is noted, however, that applicant has not filed a certified copy of the German priority application as required by 35 U.S.C. 119(b). The paper work to claim priority has been received, but a priority document of DE 100 33 454.7 was not attached to the paper work.

Withdrawn Rejections

3. The 35 U.S.C. 102 rejection of claims 1, 3 – 8, 10 – 12, 16 and 18 – 21 as anticipated by Davis et al. is withdrawn due to Applicant's amendment in Paper #12.

4. The 35 U.S.C. 102 rejection of claims 1, 19, 22 and 23 as anticipated by Hein is withdrawn due to Applicant's amendment in Paper #12.

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5. The 35 U.S.C. 103 rejection of claims 9, 13 – 15, 17, 24 and 25 over Davis et al. is withdrawn due to Applicant's amendment in Paper #12.

New Rejections

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3 – 21, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. (USPN 5,302,466).

Davis et al. disclose a strip (Column 4, line 49 and Figure 8, #82) with a plurality of opposing tabs or legs (Column 4, lines 55 – 58 and Figure 8, #88) having a thickness of 0.51 mm (Column 4, lines 49 – 50) made from metal (Column 4, line 63). Each leg is connected by a connection element (Figure 8, #94) and contains a hole, which extends transversely to the longitudinal length of the strip and mirrors the hole, which is formed across from it (Figure 8, #114). The holes contain two sections, the first section having a triangular shape with an angle between 10° to 80° that expands from the longitudinal axis towards the second section (Figure 8, #114). In between the openings of each leg and overlapping the longitudinal axis, a second connection element having the same shape (Figure 8, #110) is formed that allows the strip to extend in the longitudinal direction (Figure 8, #82) and has an angle in the range of 10° to 80°

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with respect to the longitudinal axis (Figure 8, #109). A cut-out is formed in between the legs of the strip that extends from the edge to the first connection element forming an angle within the range of 2° to 30° (Figure 8, #89). Figure 8 shows the first element extends across the longitudinal axis while the cut-outs are arranged symmetrically across from each other with parallel sides along the longitudinal axis of the strip. It also shows that the gap between the parallel sides is $1/10$ to $1/20$ of the length of the gap and has a V-shape (Column 5, lines 7 – 9), which widens as it approaches the edge of the strip. The tabs or legs are U-shaped (Column 4, line 56), having a straight edge (Figure 8, #88) with rounded corners. As may be seen in Figure 1, the legs of the strip are bent out of the plane of the longitudinal axis (Figure 1, #20) when used in a weather strip having an extruded rubber body (Column 3, lines 15 – 18). However, Davis et al. fails to disclose the second connecting element being inclined relative to said longitudinal axis, each cut-out rounded in the area of the first connecting element and forms an arc of a circle having a radius $R1$, the radius $R1$ being in the range of 0.2 to 1.5 mm, the second section includes sides that are perpendicular to the longitudinal axis and further comprising a third section that widens towards the edge of the strip and adjoins the second strip, the third section is V-shaped and is symmetrical about a perpendicular axis to the longitudinal axis and encloses an angle $W2$ which in the range of 2° to 30° from said perpendicular axis and the opening comprises a fourth section and said section is spaced apart from the edge of the strip and rounded with a radius $R2$ that is in the range of 0.5 to 5 mm.

Davis et al. disclose the claimed invention except for a third section that widens towards the edge of the strip and adjoins the second strip, the third section is V-shaped and is

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symmetrical about a perpendicular axis to the longitudinal axis and a fourth section that is rounded and spaced apart from the edge of the strip. It would have been obvious to one of ordinary skill in the art at the time the invention was made to reverse the direction of the holes in Davis et al so that the rounded edge of the opening was close to the edge of the strip, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 416. From Figure 8, the angle of the third section, once it was reversed, would be between 2° to 30°.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (Claim was directed to an advertising display device comprising a bottle and a hollow member in the shape of a human figure from the waist up which was adapted to fit over and cover the neck of the bottle, wherein the hollow member and the bottle together give the impression of a human body. Appellant argued that certain limitations in the upper part of the body, including the arrangement of the arms, were not taught by the prior art. The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.) Also, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (the court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.) In the instant case, the application does not indicate any new,

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significant attributes of the invention due to its shape, which would have been unforeseen to one of ordinary skill in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the cutout to have a semicircular shape and to change the shape of the second connecting element to have an incline relative to the longitudinal axis depending on the desired end results and absence of unexpected results. One skilled in the art would have been motivated to do so in order to form a strip that has a uniform shape down the longitudinal axis.

One of ordinary skill in the art would have recognized that the openings would have a radius of 0.5 to 5mm in the fourth section and 0.2 to 1.5 mm in the rounded area of the cutout since Davis et al. teaches using the support in weather stripping, which would require smaller openings to obtain adhesion between the support strip and the rubber. Therefore, one of ordinary skill in the art would readily determine the optimum radius for both the openings and the cutouts depending on the end desired results absence of unexpected results.

8. Claims 1, 19, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hein (USPN 4,348,443).

Hein discloses a strip (Column 3, line 33 and Figure 1, #2) with a plurality of opposing tabs or legs (Column 3, lines 48 – 51 and Figure 1, #6) made from metal (Column 3, line 33). Each leg is connected by a connection element (Figure 1, #4) and contains a hole, which extends transversely to the longitudinal length of the strip and mirrors the hole, which is

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formed across from it (Figure 1, #12). In between the openings of each leg and overlapping the longitudinal axis, a second connection element having the same shape (Figure 1, #4) is formed that allows the strip to extend in the longitudinal direction (Column 3, lines 49 - 50). The holes, openings, in the metal strip are formed with a punching die (Column 3, lines 42 - 44). However, Hein fails to disclose the second connecting element being incline relative to the longitudinal axis.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (Claim was directed to an advertising display device comprising a bottle and a hollow member in the shape of a human figure from the waist up which was adapted to fit over and cover the neck of the bottle, wherein the hollow member and the bottle together give the impression of a human body. Appellant argued that certain limitations in the upper part of the body, including the arrangement of the arms, were not taught by the prior art. The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.) Also, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (the court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.) In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape, which would have been unforeseen to one

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of ordinary skill in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the second connecting element to have an incline relative to the longitudinal axis depending on the desired end results and absence of unexpected results. One skilled in the art would have been motivated to do so in order to form a strip that has a uniform shape down the longitudinal axis.

Response to Arguments

9. Applicant's arguments with respect to claims 1 and 3 – 25 have been considered but are moot in view of the new ground(s) of rejection. However, since the previous prior art is being used in the current rejections of the claims, the arguments will be responded to below.

In response to applicant's argument that both Davis et al. and Hein fail to disclose the second element being inclined relative to said longitudinal axis which in turn leads to the tensile strength of the strip to increase while simultaneously allowing for a compression of the strip, the Examiner is unable to determine if this change in the shape of the second connecting element would cause unforeseen results since there is no proof of the improved ability. Therefore, the claims have been rejected with the shape being treated as an ornamental design of the strip of material.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-

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5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer
Examiner
Art Unit 1772

pln
pln


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

10/31/03